

Applicants respectfully submit that the rejection of claims 1, 8, 10-36 and 42-72 under 35 U.S.C. 103(a) over Erlander et al (WO 95/13369) in view of New England Biolabs catalog (page 11) (1993/1994 catalog) is unwarranted and should be withdrawn.

**Second Rejection Under 35 U.S.C. 103 (a): The Deficiencies  
Of The References Are Not Cured By Addition of Kato et al.**

Claims 1-4, 8, 10-36 and 42-72 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Erlander et al (WO 95/13369) in view of New England Biolabs catalog (page 11) (1993/1994 catalog) and further in view of Kato et al. (EP 735 144 A1). As noted above, the combination of Erlander et al. and NEB does not teach or suggest the present invention. The addition of the Kato et al. reference does not cure this deficiency. Kato et al. teaches the ligation of biotinylated double stranded cDNA adapters to double stranded cDNA fragments produced by multiple digests with class IIS restriction enzymes. Applicants respectfully point out that the method of Erlander et al. lacks a step of ligation of double stranded cDNA adapters to double stranded cDNA fragments, and does not suggest the addition of such a step. Furthermore, the method of the present invention does not teach or claim the step of ligation of double stranded cDNA adapters to double stranded cDNA fragments. Thus, there would be no motivation for one of skill in the art to combine the teachings of the references to arrive at the present claimed invention.

Applicants respectfully submit that the rejection of claims 1-4, 8, 10-36 and 42-72 under 35 U.S.C. 103(a) over Erlander et al (WO 95/13369) in view of New England Biolabs catalog (page 11) (1993/1994 catalog) and further in view of Kato et al. is unwarranted and should be withdrawn.

**Third Rejection Under 35 U.S.C. 103 (a): The Deficiencies  
Of The References Are Not Cured By Noronha et al.**

Claims 1, 5-7, 8, 10-36 and 42-72 are rejected in the Office Action mailed October 18, 2000 under 35 U.S.C. 103(a) as being unpatentable over Erlander et al (WO 95/13369) in view of New England Biolabs catalog (page 11) (1993/1994 catalog) and further in view of Noronha et al (PCR Methods Appl (1992) 2:131-136). As noted above, the combination of Erlander et al. and NEB does not teach or suggest the present invention. The addition of the Noronha et al. reference does not cure this deficiency.

Applicants respectfully submit that the rejection of claims 1, 5-7, 8, 10-36 and 42-72 under 35 U.S.C. 103(a) over Erlander et al (WO 95/13369) in view of New England Biolabs catalog (page 11) (1993/1994 catalog) and further in view of Noronha et al. is unwarranted and should be withdrawn.

**Fourth Rejection Under 35 U.S.C. 103 (a): The Deficiencies Of The References Are Not Cured By Ju et al.**

Claims 1, 8-36 and 42-72 are rejected in the Office Action mailed October 18, 2000 under 35 U.S.C. 103(a) as being unpatentable over Erlander et al (WO 95/13369) in view of New England Biolabs catalog (page 11) (1993/1994 catalog) and further in view of Ju et al (Anal. Biochem. (1995) 231:131-140). As noted above, the combination of Erlander et al. and NEB does not teach or suggest the present invention. The addition of the Ju et al. reference does not cure this deficiency.

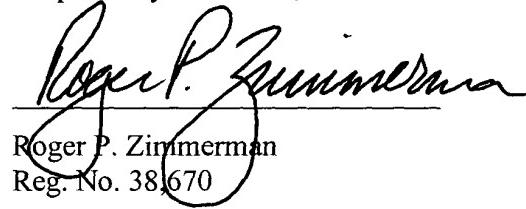
Applicants respectfully submit that the rejection of claims 1, 1, 8-36 and 42-72 under 35 U.S.C. 103(a) over Erlander et al (WO 95/13369) in view of New England Biolabs catalog (page 11) (1993/1994 catalog) and further in view of Noronha et al. is unwarranted and should be withdrawn.

**CONCLUSION**

For the foregoing reasons, the Applicants respectfully assert that the claims are in proper condition for allowance, and request that the Examiner grant the application.

Please contact Roger P. Zimmerman at (312) 913-2101, if there are any questions regarding this matter. Please debit or credit any fees occasioned by this paper to Deposit Account No. 13-2490.

Respectfully submitted,

  
\_\_\_\_\_  
Roger P. Zimmerman  
Reg. No. 38670

Date: April 24, 2001

By:

**McDonnell, Boehnen, Hulbert & Berghoff**  
300 South Wacker Drive, 32<sup>nd</sup> Floor  
Chicago, IL 60606  
Telephone: (312) 913-0001  
Facsimile: (312) 913-0002





1998/99